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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/896,514	06/23/1997	CONRAD OLIVER GARDNER	95-004M	3272

7590 10/21/2005

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EXAMINER

MORRIS, LESLEY D

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/896,514	Applicant(s) GARDNER, CONRAD OLIVER	
	Examiner Lesley D. Morris	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-41, 46-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-33 is/are allowed.
- 6) ☐ Claim(s) 34-36, 46-51, 54--61 is/are rejected.
- 7) ☒ Claim(s) 37-41, 52 and 53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is in response to the Remand from the Board of Appeals directed to Appellants Evidence in the form of an affidavit from Philip C. Malte submitted August 23, 2005. This submittal has been taken as "reopening prosecution" with respect to the new rejection of claims 55 and 59 instead of "requesting rehearing".

2. The current status of the claims based upon the Board of Appeals decision in this application is as follows:

Claims 30-33 stand allowed. Claims 38, 39, 52, 53 stand objected to as depending from rejected claims but otherwise indicated as allowable (answer, p 2). The rejection under 35 USC 112, second paragraph, stands affirmed as to claims 49 and 58 and reversed as to claims 46-48, 55, 57, 60 and 61; the anticipation rejection based on Ellers stands affirmed as to claims 34-36, 50, 54, 57, 60 and 61 and reversed as to claims 37, 58 and 59; the anticipation rejection based on Kenyon stands affirmed as to claims 46, 47, 51 and 61 and reversed as to claims 37, 40 and 55; the anticipation rejection based on Lynch stands affirmed as to claims 50, 51, 57 and 60 and reversed as to claims 37, 40, 54, 55, 58 and 59; the rejection of claim 41 under 35 USC 103 stands reversed; the rejections of claims 56 and 48 under 35 USC 103 stands affirmed; and a new rejection of claims 55 and 59 has been entered pursuant to 37 CFR 41.50(b) based upon Lynch in view of Applicant's admission on page 7 of the specification that nickel cadmium batteries were known in the art at the time of Appellants' invention and are "fast charge-discharge" batteries.

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3. Applicant's arguments filed August 23, 2005 have been fully considered but they are not persuasive. Appellant argues that there is no motivation to combine the known nickel-cadmium batteries with the hybrid vehicle of Lynch other than hindsight. This will be addressed below in conjunction with the subject matter of the affidavit. The affidavit by Philip C. Malte merely presents the "bad side of the coin" with respect to nickel cadmium batteries instead of any overriding concrete reasons that would overcome the rejection under 35 USC 103. The mere facts that nickel-cadmium batteries are not maintenance free and require special handling when no longer in use and that such batteries were only available from one source at the time of the invention (mid 1990's) does not obviate someone of ordinary skill in the art at the time of the invention (mid 1990's) choosing such batteries for use in the device of Lynch in order to have a battery "designed for short duration, high current discharge and have low internal resistance" (column 5, lines 16-18). Thus, any battery that would meet this requirement can be readily utilized in the device of Lynch. Appellant specifically admits on page 7 of the specification that nickel-cadmium batteries were known at the time and were labeled as "fast charge-discharge" batteries. Thus, in view of the battery requirement taken directly from Lynch and Appellant's own admission concerning nickel-cadmium batteries ample motivation for one of ordinary skill in the art to use known batteries, such as nickel cadmium batteries in the hybrid vehicle of Lynch is indeed present. The affidavit also goes on to point out that nickel-cadmium batteries have never caught on as automotive propulsion. Just because they have not achieved common everyday status as a form of automotive propulsion does not overcome that facts that they were known to exist at the

time of the invention and were known as "fast charge-discharge" batteries and could have been utilized in the device of Lynch since they meet the battery requirement stipulated therein. As to Appellant's Declaration concerning request for "Pioneer Status", such statements are not deemed to be persuasive in any respect. The mere fact that parent applications of this current application have been patented and then cited as prior art in 53 other applications is not overwhelming evidence of "pioneer status". Furthermore, "Pioneer Status" would not obviate a rejection under 103.

4. Claims 55 and 59 are rejected under 35 USC 103 as being unpatentable over Lynch in view of the admission on page 7 of the appellant's specification that nickel cadmium batteries were known in the art at the time of the appellant's invention and are "fast charge-discharge" batteries. When the motor-generator 12 of Lynch is operating at speeds above the no-load speed, it acts as a generator and puts a load on the internal combustion engine which brings the speed of the engine back toward the no-load speed and at the same time converts any excess engine power into electric energy to be stored in the batteries. As such, Lynch's hybrid vehicle captures power from a continuously running low horsepower engine (see column 9, lines 7-8) without loss of power to the vehicle, as called for in step a of claim 55, and transfers power output from the engine into electric power conserved in the battery, as recited in step b of claim 59. As for the step "providing instant powerful acceleration by operator depression of the throttle pedal to provide electric propulsion while in the cruise mode when the speed of the vehicle is dropping" in claim 55 and the step of causing a battery to power the electric motor on throttle demand in claim 59, Lynch discloses that, when

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the engine is subjected to increasing loads, such as those encountered when the vehicle begins ascending a hill and sudden acceleration is demanded to counter the dropping vehicle speed, the increased load causes the engine to slow down below its preferred speed, which is also the no-load speed of the motor-generator, and the motor-generator functions as a motor and transfers energy from the storage battery to the drive shaft, thereby increasing the speed of the vehicle and, hence, of the engine back toward its preferred speed. See column 3, third paragraph. Lynch also discloses that "the batteries should be designed for short duration, high current discharge and have low internal resistance" (column 5, lines 16-18). This would have provided ample motivation for one of ordinary skill in the art to use known batteries, such as nickel cadmium batteries, which appellant admits on page 7 of the specification were known in the art at the time of the appellant's invention and are "fast charge-discharge" batteries as that terminology is used by the appellant, for the storage batteries 14.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication should be directed to Lesley D. Morris at telephone number 571 272-6651.

A handwritten signature in black ink that reads "Lesley D. Morris". The signature is fluid and cursive, with the first letters of each word being capitalized and prominent.

Lesley D. Morris
SPE
Art Unit 3611

LDM

10/17/05